

## Remarks

## Abstract

The revised abstract is enclosed, which does not use "said".

## Specification

The substitute specification filed April 23, 2002 contains no new matter.

New claim 39 overcomes the objections according to numbered paragraphs 7, 8 and 10 of the Office Action.

New claim 39 adds an ejector sleeve, which is movable on the counter-holder. This feature is disclosed in the originally filed description on page 2, paragraph [0006] and page 5, first paragraph [0016], second line to the last line.

Furthermore to claim 39 the feature "a slide carrying the at least one cutting tool and ejector" has been added. This is disclosed on page 5, paragraph [0016] lines 4 and 5.

Due to the new claim 39 the advantages described on page 2, last paragraph will be achieved.

The features according to the new claim 39 and dependent claims comprising a cutting tool and an ejector for the inventive apparatus belong together for having an apparatus with short cycle times for cutting tubular sleeves having different or equal length. Therefore these claims belong to one group.

## Claim Rejections 35 USC 103

To establish a *prima facie* case of obviousness under 35 USC 103(a) the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or imply suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why

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the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” (MPEP 706.02(j))

An apparatus according to new claim 39 is new and inventive over Luce, Sr. in view of Sappenfield or Engel et al.

Luce discloses an apparatus for cutting a cylindrical tube into a plurality of tube sleeves. Luce discloses a slide bar 19 having two cutter assemblies 14, which will be manually fixed in a predetermined distance on the bar 19. After fixing them in a predetermined distance to the slide bar 19 and positioning a tube onto the mandrel, the cutting process will be started.

This cutting process is totally different to that of the present invention. A hydraulic cylinder positioned by a piston rod moves the slide bar along the tube and both cutter assemblies will cut the tube simultaneously into two set of rings of the same size. Even if there might be only one cutting assembly positioned on the slide bar, it is not possible to cut sleeves along the whole tube and to cut them with various free-programmable length of the sleeves.

Furthermore, Luce does not disclose an ejector. The man skilled in the art does not get any hint from Luce to provide an ejector and to actuate this ejector by a slide that is also responsible for the movement of the cutting tool.

The ejector disclosed by Sappenfield has a totally different function from that one according to the present invention and is used in a quite different way. Sappenfield's ejector is pivotally supported on the fixed member by a ball and is therefore not moveable along the mandrel.

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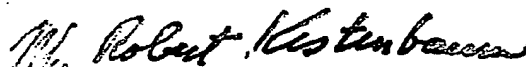
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Engel et al does not at all disclose an ejector, which is moveable along the mandrel.

Wherefore, we respectfully request that the claims in this application be considered and allowed.

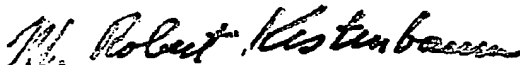
A one-month extension of time in which to respond to the outstanding Office Action is hereby requested. Credit Card Payment Form PTO-2038 is enclosed to cover the prescribed Large Entity one-month extension fee of \$110.00.

Respectfully submitted,



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I hereby certify this correspondence is being submitted to Commissioner for Patents, Alexandria, VA 22313-1450 by facsimile transmission on July 20, 2004, fax number (703) 872-9306.



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